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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,361	07/17/2000	David N. Harris	0013-011	8110

7590 03/25/2004

Henneman & Saunders
121 E 11th Street
Tracy, CA 95376

EXAMINER

KEMPER, MELANIE A

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,361

Applicant(s)

HARRIS, DAVID N.

Examiner

M Kemper

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-28, 30-44 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-28, 30-44, 46-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language "operative to wait for said account-holder to initiate said connection with said account-holder" is confusing. This claim was examined similar to claim 24 which includes waiting for the account-holder to initiate communication with the computer system.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 14, 16-22, 29-30, 32-38, 46, 48, 50, 52-53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blonder et al., patent number 5,708,422.

Blonder teaches a method for verifying a commercial transaction comprising: receiving a transaction approval request from the merchant, the request including the account number (col. 2, lines 60-65, lines 45-50, col. 4, lines 55-65, col. 5, lines 5-10); electronically verifying the approval request with the account holder via a separate

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communication from the merchant (see at least col. 2, lines 50-55, col. 3, lines 5-15, 25-35, col. 5, lines 40-50, col. 6, lines 50 – col. 7, line 5) and transmitting an approval to the merchant only if request is verified by the account holder (col. 3, lines 1-5, col. 10, lines 35-37).

Blonder also teaches a computer system for verifying a commercial transaction comprising: a processing unit for processing data and code, a memory device for storing data and code including a merchant communications module to facilitate a connection with the merchant for receiving a transaction approval request including a complete account number (fig. 1, col. 2, lines 60-65, lines 45-50, col. 4, lines 55-65, col. 5, lines 5-10); an account holder communications module operative to facilitate a separate connection with the account holder for verifying the request (see at least col. 2, lines 50-55, col. 3, lines 5-15, 25-35, col. 5, lines 40-50, col. 6, lines 50 – col. 7, line 5); and an authorization module responsive to receipt of the approval request and transmitting an approval to the merchant only if the approval request is verified by the account holder (fig. 7, fig. 9, fig. 10 (at least), col. 10, lines 35-37).

Blonder also teaches the authorization module includes an interactive verification module responsive to the approval request and initiating a connection with the account holder and verifying the transaction request by prompting the account holder to verify the request (col. 7, line 65 – col. 9, line 30); sending an electronic message to the account holder via a network interface and receiving a reply to the electronic message (col. 6, lines 55 – col. 7, line 3, col. 9, lines 10-30); a telecommunications device where the interactive verification module places an automated telephone call to the account

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holder and includes establishing a telephone connection with the account holder, reciting a portion of the request to the account holder, and receiving verification instructions from the account holder (col. 8, lines 10-55); the authorization module is responsive to instructions from the account holder to automatically verify subsequent transaction approval requests without further input from the account holder and instructions for enabling or disabling the electronic verification (col. 5, line 30-45, col. 7, lines 1-10, col. 14, lines 35-67) and transmitting approval only if the transaction approval request is verified by the account holder or if verifying the approval request has been disabled (fig. 7); disabling any notification to the account holder (alert and/or approval flags set); the authorization module includes a master verification module responsive to the lapse of a predetermined time period and operative to disclaim the request if the request has not been verified by the account-holder (col. 7, lines 5-15, col. 10, lines 5-20, lines 55-65); the transaction approval request is a verification request from a third-party financial institution and the authorization module transmits indicia of verification to the third party institution (col. 5, lines 30-35, col. 9, lines 25-30).

Blonder also teaches a processing unit and memory device with code including a financier communications module operative to facilitate a connection with a financier for receiving a verification request, an account holder communications module to facilitate a connection with the account holder; and an authorization module responsive to the receipt of the verification request and transmitting an approval to the financier (col. 7, lines 28-35, col. 8, lines 15-40, col. 9, lines 10-30, col. 15, line 60 – col. 16, line 3, lines 15-22).

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Blonder also teaches a method for verifying commercial transactions comprising: receiving a verification request associated with the transaction from a financial institution that approves transaction; electronically verifying the transaction with the account holder; and transmitting indicia of verification to the financial institution (col. 7, lines 28-35, col. 8, lines 15-40, col. 9, lines 10-30).

5. Claims 1-6, 8-9, 11, 14-22, 24-25, 27, 29-38, 40-41, 43, 46-49, 51-52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Joao et al., patent number 6,529,725.

Joao teaches a method for verifying a commercial transaction comprising: receiving a transaction approval request from the merchant, the request including the account number (col. 5, lines 35-45, col. 17, lines 5-20); electronically verifying the approval request with the account holder via a separate communication from the merchant (see at least col. 6, lines 15-25, col. 6, lines 45-65) and transmitting an approval to the merchant only if request is verified by the account holder (col. 7, lines 30-40).

Joao also teaches a computer system for verifying a commercial transaction comprising: a processing unit for processing data and code, a memory device for storing data and code including a merchant communications module to facilitate a connection with the merchant for receiving a transaction approval request including a complete account number (col. 4, lines 5-65, col. 5, lines 25-50, col. 17, lines 5-20); an account holder communications module operative to facilitate a separate connection with the account holder for verifying the request (col. 4, lines 45 – col. 5, line 25, col. 6,

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lines 15-35); and an authorization module responsive to receipt of the approval request and transmitting an approval to the merchant only if the approval request is verified by the account holder (col. 6, lines 45-65, col. 7, lines 30-40).

Joao also teaches the authorization module includes an interactive verification module responsive to the approval request and initiating a connection with the account holder and verifying the transaction request by prompting the account holder to verify the request (col. 6, lines 35-65, col. 11, lines 15-20); sending an electronic message to the account holder via a network interface and receiving a reply to the electronic message (col. 10, lines 50-65); a telecommunications device where the interactive verification module places an automated telephone call to the account holder and includes establishing a telephone connection with the account holder, reciting a portion of the request to the account holder, and receiving verification instructions from the account holder (col. 10, lines 50-60, col. 6, lines 20-35, col. 6, lines 50-60, col. 37, lines 50-55); the authorization module includes an interactive verification module operative to wait for the account holder to initiate the connection with the computer system (col. 7, lines 12-18, col. 19, lines 1-10, line 65- col. 20, line 5); a network interface operative to wait for a communication from the account holder (col. 37, lines 25-30, col. 38, lines 15-25, 40-65); a telecommunications device wherein the verification module is operative to wait for a telephone call from the account holder (col. 19, lines 1-10, col. 6, lines 60-65); the authorization module is responsive to instructions from the account holder to automatically verify subsequent transaction approval requests without further input from the account holder (col. 11, lines 1-10, col. 7, lines 45-67); the authorization module

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includes a master verification module responsive to the lapse of a predetermined time period and operative to disclaim the request if the request has not been verified by the account-holder (col. 6, lines 65-67, col. 7, lines 4-6); the transaction approval request is a verification request from a third-party financial institution and the authorization module transmits indicia of verification to the third party institution (col. 21, lines 20-40); the master verification module is operative to transmit notice to the account holder when the transaction approval request is disclaimed (col. 8, lines 10-25, 55- col. 9, line 5); the step of electronically verifying the request with the account holder can be enabled or disabled by the account holder (col. 11, lines 1-10).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al., patent number 5,708,422.

While Blonder teaches the interactive verification module requires authentication from the account holder prior to reciting a portion of the approval request (col. 8, lines 45-50), Blonder does not teach the use of an authentication code for this purpose. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used an authentication code prior to reciting a portion of the approval request in Blonder since, at least, personal identification numbers, or pin, are

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well known in the art for identifying/authenticating customers (claims 15,25). Use of the pin authentication would have at least reduced the processing and storage demands of voice recognition particularly considering the number of customers the system would need to serve.

8. Claims 8-12, 15, 24-28, 31, 39-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. in view of Joao et al.

Blonder teaches establishing a connection with the account holder, authenticating the account holder, transmitting a portion of the approval request, and receiving verification instructions from the account holder with respect to the approval request (col. 8, lines 10-55), but does not show waiting for a connection initiated by the account holder. Joao teaches the account holder can contact the central processing office or processing center to approve the transaction (col. 7, lines 12-18, col. 19, lines 1-7, col. 19, line 65 – col. 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have waited for the customer to initiate communication with the system as in Joao since this would have provided the customer the time he/she needed to decide whether to approve/disapprove the transaction. It also would have been obvious to have transmitted a notice to the account holder when the transaction approval request was disclaimed as in Joao since this would have provided a complete record of activity for the account holder.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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10. Claims 8,24,49,51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Upon further review of the specification, support for notification to the account holder being disabled was not found.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elston, patent number 6,055,505 teaches disabling notification (col. 3, lines 25-35).

12. Applicant's arguments filed on 12/15/03 have been fully considered but they are not persuasive. The applicant argues that Blonder does not teach a module responsive to instructions from said account-holder that is operative to automatically verify subsequent transaction approval requests without further input from said account-holder since there is no indication that a user can connect with the validation database. The examiner respectfully disagrees. Blonder teaches flags that can be set for the alert and/or approval fields which are selected by the card owner (col. 6, lines 5-15, col. 6, lines 45-50). Also, due to the time restrictions such as when the card owner cannot be reached an update to the profile would be needed. Further, the profile is specified by the principle (col. 2, line 60) and, thus, shows that the account-holder has control over the limitations of the profile. Also, with reference to the fifth embodiment of Blonder, the process does suspend the verification process such that the subsequent transactions are automatically verified (col. 14, lines 35 – col. 15, line 27).

The applicant argues that Joao et al does not disclose suspending verification at the processing center. However, please see at least col. 16, lines 10-35 which includes the programmed authorization features including authorizing based on time, vendors, etc. at the central processing computer. For clarification purposes, the portion of col. 11 shows further programmable features including a deferred authorization to the extent that a subsequent transaction would include a delayed authorization.

Upon further review of the specification, disabling a notification and waiting for the account-holder to initiate communication with the computer system was not found. The applicant is encouraged to show support for the amendment in response to this office action or cancel the amended claims. Support was found for an initiate verification flag (p. 17) which could be used in an amendment.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

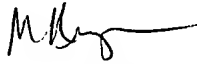
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


M Kemper
Primary Examiner
Art Unit 3622

MK